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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 120-202	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>November 23 2005</u> Signature <u>David A. Dagg</u> Typed or printed name <u>DAVID A. DAGG</u>		Application Number <u>09/707280</u>	Filed <u>11/6/2000</u>
		First Named Inventor <u>Jackson</u>	
		Art Unit <u>2155</u>	Examiner
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		Signature <u>David A. Dagg</u> Typed or printed name <u>David A. Dagg</u> Telephone number <u>978 264-6664</u> Date <u>NOVEMBER 23 2005</u>	
<input type="checkbox"/> applicant/inventor.			
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71, Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)			
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>37,809</u>			
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Jackson

Application No.: 09/707,280

Filed: 11/06/2000

Title: System, Device and Method for Providing
Personalized Services in a Communication System

Attorney Docket No.: 120-202 2204/A89

Group Art Unit: 2155

Examiner: Lazaro

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Mail Stop AF
Commissioner for Patents
P.O. Box 1450
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By FacsimilePre-Appeal Brief Request for Review

Dear Sir:

Applicants hereby request a Pre-Appeal Brief review of the above identified patent application. Applicants file this Request for a Pre-Appeal Brief review so that the panel of Examiners may determine whether the Office Actions of record adequately establish that: (1) claims 1-5, 7-16, 18-24, 26-35, 37-40, 42-48, 50-59, 61-64, and 66-75 are anticipated under 35 U.S.C. 102(e) by U.S. Patent 6,331,972 to Harris et al. ("Harris et al."); (2) dependent claims 6, 25 and 49 are *prima facie* obvious under 35 U.S.C. 103 over Harris et al. and U.S. patent number 6,104,913 of McAllister ("McAllister"); and (3) dependent claims 17, 36, 41, 60 and 65 are *prima facie* obvious under 35 U.S.C. 103 over Harris et al. and U.S. patent number 5,493,692 of Theimer et al. ("Theimer et al."). Applicants submit the Examiner has failed to carry his burden of showing that each and every limitation of the independent claims is taught by Harris et al., such that there is a clear legal and factual deficiency in the rejection, as shown below:

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1. The Examiner has failed to provide a reference or combination of references that describes or suggests the claim limitation of detecting physical presence of a user, wherein the detecting includes a determination, based on at least one physical attribute of the user, that the user is currently in close physical proximity to the communication system, because the peer electronic devices in the communication network of Harris et al. are not users, and the determination of proximity based on detecting a signal on a wireless link in Harris et al. is not a determination of proximity based on at least one physical attribute of a user.

It is well established that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). In the present case, claims 1-68 and 71-75 are currently pending. Claims 1, 21, 45 and 71 are independent. At issue is whether the Harris et al. reference teaches detecting physical presence of a user, wherein the detecting includes a determination, based on at least one physical attribute of the user, that the user is currently in close physical proximity to the communication system, as in the present independent claims. Applicants respectfully submit that Harris et al. instead teaches detecting the physical proximity of electronic devices to each other based on detection of a signal on a wireless communication link. Harris et al. expressly discloses determination of device proximity beginning at line 11 of column 9:

Generally, task 58 allows a first *peer* 20 to determine whether a second *peer* 20 is physically proximate to the first peer 20. Task 58 causes transmit and receive section 38 (FIG. 2) to *monitor wireless communication link* 26 (FIG. 1) to determine whether a signal compatible with a protocol being used by network 22 (FIG. 1) can be received. Due to the above-described low transmission power levels used by peers 20, *when a signal is*

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detected, the peer 20 sending the signal is located near the receiving peer 20.
(emphasis added)

As shown in the above text, the proximity of a peer network device is determined in Harris et al. by detection of a signal transmitted on a wireless communication link by that peer. The peers of Harris et al. are clearly described as electronic devices in a communication network. At the outset of the Detailed Description, Harris et al. defines "peers" beginning at line 11 of column 6, as follows:

FIG. 1 is a layout diagram depicting relationships between various peers (P) 20 in capability addressable, wireless, peer-to-peer data communication network 22 configured in accordance with the teaching of the present invention. While FIG. 1 shows only few peers 20, *virtually any computer or microprocessor controlled electronic device throughout the world may serve as a peer 20.* Accordingly, network 22 supports an unlimited number of possible connections between peers 20. (emphasis added)

These teachings of Harris et al. stand in sharp contrast to the features of the present independent claims, which involve detecting physical presence of *a user* that includes determining that *the user is currently in close physical proximity to the communication system, based on at least one physical attribute of the user.* The peer electronic devices in the communication network of Harris et al. are clearly not users, as that term would be understood by those skilled in the art. Additionally, the detection of a signal transmitted onto the wireless communication link by the peer electronic devices in Harris et al. cannot be considered a determination based on a physical attribute of a user, since the determination in Harris et al. is based on the presence or absence of the signal on the link. Accordingly, the peer devices in Harris et al. do not correspond to the user of the present independent claims, and the determination of device proximity based on detecting the presence of a wireless signal in Harris et al. is completely different from the

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determination of user proximity based on a physical attribute of the user, as in the present independent claims.

Applicants disagree with the Examiner's assertion that lines 2-45 of column 6 in Harris et al. describe the above features of the present claims, since that section is another example of the teaching in Harris et al. of establishing a communication link between two electronic devices as a result of their determined proximity. With regard to lines 4-8 in column 21 of Harris et al., the teaching of "storing or broadcasting an identifier or indicator of the person's presence or location" by a peer electronic device provides no indication of any determination, based on at least one physical attribute of the user, that the user is currently in close physical proximity to a communication system. The text of Harris et al. in column 8, lines 10-12 refers to changing stored personalization data of a user or owner of a peer device, and also lacks any disclosure of a determination, based on at least one physical attribute of the user, that the user is currently in close proximity to a communication system. Applicants reiterate that the teaching of Harris et al. with regard to determining proximity is that of determining proximity between network devices, which is performed for the purpose of establishing a personal area network of peer devices, and is based on detecting the presence or absence of a signal transmitted by a device on a wireless communication link.

The Examiner further cites column 4, lines 10-15 in Harris et al., but this section only sets forth the desirability of automatic device configuration, without a specific teaching of how to accomplish the desired result. Lines 7-16 of column 10 in Harris et al. describe personalization of appliances as an advantage flowing from the operation of the Harris et al. system. However, these advantages are accomplished in Harris et al. through a system of peer device proximity determination, which is fundamentally different from detecting physical presence of a user,

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wherein the detecting includes a determination, based on at least one physical attribute of the user, that the user is currently in close physical proximity to the communication system, as in the present independent claims.


The Examiner has also failed to establish a *prima facie* case of obviousness under 35 U.S.C. 103. Applicants respectfully urge that the above discussed limitations of the present independent claims are also not disclosed or suggested by the combination of Harris et al. and McAllister, which the Examiner has cited as basis for rejecting dependent claims 6, 25 and 49, nor by the combination of Harris et al. and Theimer et al., which the Examiner has cited as basis for rejecting dependent claims 17, 36, 41 and 65. Specifically, neither McAllister nor Theimer et al. provide any teaching or suggestion of the limitations not found in Harris et al.

For these reasons, Applicants respectfully request that the above application be reviewed by the pre-appeal panel. If the panel determines that the Examiner has not made a *prima facie* showing of anticipation and/or obviousness, Applicants respectfully request withdrawal of the rejections and allowance of the pending claims.

Respectfully Submitted,

NOVEMBER 23 2005

Date


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